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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,444	02/07/2002	Tsuneyoshi Saitoh	55078US005	3905

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EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 02/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/049,444

Applicant(s)

SAITOH, TSUNEYOSHI 

Examiner

Daniel Zirker

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.
- NOTE: _____
3. ☒ Applicant's reply has overcome the following rejection(s): 35USC112, 2nd para rejection of record.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached NOTE.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: _____

Claim(s) rejected: 1,3-7.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1800-
1700



NOTE

1. Applicant's submitted after final response has been entered, although it could technically be argued that the amendments to claim 3 constitute a new issue. However, the Examiner addressed this issue in paragraph No. 2 of the final rejection, and accordingly has entered the amendment which overcomes the 35 U.S.C. § 112, second paragraph rejection of record.

2. The prior art rejection of claims 1 and 3-7 as being unpatentable over EPA -570 taken in view of JP -771 as set forth in the final rejection in paragraph No. 3 is hereby repeated, particularly with respect to the central issue of the case, namely are the references combinable subject material or, alternatively, is their combination hindsight. It is initially noted that the term "protective layer" found in applicant's claims is typically believed to be a paint film. Additionally, EPA -570, while not reciting paint films as their "weather resistant flexible substrate" is believed to ^{have its "flexible substrates"} also be coated with protective films which can typically include paint films. As such, the incorporation of a hydrophilic agent found in paint into the weather and dirt resistant coated films of EPA -570 is not seen to be an outrageous piece of hindsight, but rather an obvious substitution to one of ordinary skill in the coated protective film art. Note also that applicant in his

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specification (page 2, lines 5-7) teaches that "incorporation of a decomposable hydrophilic agent as a dirt resistant agent into paint has been attempted" to solve these problems. Finally, with respect to applicant's remarks (Response, page 8, third complete paragraph) that the structures of the dependent claims are not taught or hinted at by the relied upon reference combination the Examiner notes that, in particular, claim 14 of EPA -570 is believed to clearly put within the skill of the art when combined with JP -771 the remaining structure set forth in the dependent claims.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (571) 272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-0994.

Dzirker:cdc
January 28, 2004